

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
June 29, 2004
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Great Lakes Ramco, Inc.

Serial No. 76302658

Kenneth L. Mitchell of Woodling Krost and Rust for Great
Lakes Ramco, Inc.

John C. Hwang, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Bucher, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Great Lakes Ramco, Inc. seeks registration on the
Principal Register of the mark GREAT LAKES RAMCO for
services recited, as amended, as "business management
services," in International Class 35.¹

This case is now before the Board on appeal from the
final refusal of the Trademark Examining Attorney to

¹ Application Serial No. 76302658 was filed on August 20,
2001 based upon applicant's allegation of a *bona fide* intention
to use the mark in commerce. The words "GREAT LAKES" are
disclaimed apart from the mark as shown. On April 4, 2002,
applicant filed an amendment to allege use, alleging first use in
commerce at least as early as August 31, 2001.

register this designation based upon the ground that applicant has not submitted a proper specimen of use verified to have been in use in commerce prior to the date of filing of the amendment to allege use.

The recitation of services in the application, as filed, was simply "management services." At the time of filing of the amendment to allege use, based upon the Trademark Examining Attorney's suggestion in the initial Office action, applicant amended the recitation to "business management services." However, the specimen submitted with the amendment to allege use was a blank invoice listing applicant's trade name and the legend "Sales - Rentals - Parts - Service." The Trademark Examining Attorney objected to this specimen inasmuch as it made no reference to the recited services.

Applicant then submitted substitute specimens in the form of copies of advertising flyers promoting applicant's material handling businesses - again, listing sales, service, parts and rentals. Like the invoice submitted with the amendment to allege use, these substitute specimens were properly supported by a declaration. However, again, the Trademark Examining Attorney correctly

objected to these specimens as failing to make any mention of the recited business management services.

In its response of April 22, 2003, applicant submitted a partial photocopy of a brochure stating in part as follows:

RIM® -- Remote Inventory Management

Great Lakes-Ramco recognizes the need to "track" inventory levels in real time and offers this service to its clients via our Remote Inventory Management program (RIM®). The RIM® program identifies inventory levels immediately and adjusts quantities to pre-determine levels automatically. RIM® eliminates the risk of inventory deficits while offering management cost prediction and control of inventoried parts usage.

In the final Office action, the Trademark Examining Attorney noted the outstanding issues, as follows:

Applicant's substitute specimen indeed shows that applicant provides inventory management of material handling equipment as a subset of its retail parts distribution services. Applicant may amend its identification to "inventory management services in the field of material handling equipment parts."

Although applicant's substitute specimen shows inventory management services, the applicant must verify, with an affidavit or a declaration under 37 C.F.R. §2.20, that the applicant used the substitute specimen in commerce prior to filing the amendment to allege use. 37 C.F.R. §2.59(b)(1). Applicant omitted submitting this statement and declaration.

Based on the language in the final Office action, the examining attorney apparently concluded that applicant's inventory management services were within the scope of its identified business management services. Therefore, the

examining attorney clearly allowed applicant to remedy irregularities in the application by amending the identification and by submitting a verification for the brochure showing use of applicant's mark for inventory management services. However, instead of amending the identification and submitting a verification, which apparently would have led to approval for publication of applicant's mark, applicant filed this appeal.

Simply stated, throughout the prosecution of this application, the recitation of services has been limited to "management services" and then "business management services." This language implies that applicant is providing the service of managing the business operations of another in some form. With the Trademark Examining Attorney's final suggestion of yet another more precise recitation of services, he clearly had determined that these "inventory management services" were still within the scope of the earlier recited services. See 37 C.F.R. §2.71(a).

As noted above, the first specimen of record (the blank invoice) made no clear reference to any particular service, and certainly did not allude to a service of managing the business operations of another. The

substitute specimens (the flyers) demonstrate clearly that applicant is in the business of meeting the material handling needs of its clients, but again, make no reference to managing the business operations of another. Thus, neither of the verified specimens showed use of the mark for the identified services.

Finally, as pointed out by the Trademark Examining Attorney, the most recently submitted brochure would appear to be acceptable to support the proposed amended recitation of services, but lacks the critical verification required by 37 C.F.R. §2.59(b)(1). We do not understand applicant's statement that "[n]o substitute specimen has been submitted and no verification is necessary." Taken literally, applicant apparently did not submit the brochure showing use of its mark for inventory management services as a substitute specimen and must have submitted it solely for informational purposes. We must, therefore, determine whether applicant has submitted a proper, verified specimen showing use of its mark for its identified business management services by referring only to the invoice submitted with the amendment to allege use and the verified substitute submitted when the examining attorney refused to accept the invoice as a proper specimen. Neither the

invoice nor the verified substitute therefore show use of applicant's mark for the identified business management services. Accordingly, the refusal of registration for failure to comply with the requirement to submit a proper, verified statement is affirmed.

Decision: The refusal to register based upon applicant's failure to submit a proper, verified substitute specimen is hereby affirmed.